

REMARKS:

Claims 1-32 are currently pending in the application. Claims 1, 2, 4, 6-13, and 16-32 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,484,149 to Jammes et al. ("*Jammes*"). Claims 3, 14, and 15 stand rejected under 35 U.S.C. § 103(a) over Jammes in view of U.S. Patent No. 5,758,328 to Giovannoli ("*Giovannoli*"). Claim 5 stands rejected under 35 U.S.C. § 103(a) over Jammes in view of U.S. Patent Application Publication No. 2005/0261983 to Etten et al. ("*Etten*").

By this Amendment, the Applicant has amended independent claims 1, 10, 21, and 32 and dependent claims 2-7, 11-19, and 22-30 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant make no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicant reserves the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1-32. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 112:

The Applicant thanks the Examiner for withdrawing the rejection of claims 1-9 under 35 U.S.C. § 112.

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1, 2, 4, 6-13, and 16-32 stand rejected under 35 U.S.C. § 102(b) over *Jammes*.

Although the Applicant believes claims 1-32 are directed to patentable subject matter without amendment, the Applicant has amended independent claims 1, 10, 21, and 32 and dependent claims 2-7, 11-19, and 22-30 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Applicant has reviewed *Jammes* in detail, particularly looking for an electronic commerce system, method, or software for applying dynamic database redirection. However, *Jammes* fails to disclose each and every limitation recited by claims 1, 2, 4, 6-13, and 16-32. Thus, the Applicant respectfully submits that claims 1, 2, 4, 6-13, and 16-32 patentably distinguish over *Jammes*.

***Jammes* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to amended independent claim 1, this claim recites:

An ***electronic commerce system applying dynamic database redirection***, the system comprising:

one or more seller databases including product data for one or more products;

a ***seller selection interface*** operable to ***receive one or more seller requirements from a buyer***,

a ***global content directory server*** associated with the seller selection interface, the global content directory server operable to ***generate one or more custom global content directories based on the seller requirements received from the buyer***,

one or more ***custom global content directories*** each including a ***plurality of product classes*** organized in a hierarchy, each product class categorizing a plurality of products from one or more sellers ***satisfying the seller requirements received from the buyer*** and each product class associated with one or more attributes of the products categorized in the product class, at least one of the ***product classes having one or more associated pointers that identify one or more seller databases associated with sellers satisfying the seller requirements received from the buyer***, and

a search interface associated with the one or more custom global content directories, the search interface operable to communicate a search query to the seller databases to search the product data stored in the seller databases identified by one of the pointers. (Emphasis Added).

Amended independent claims 10, 21, and 32 recite similar limitations. *Jammes* fails to disclose each and every limitation of amended independent claims 1, 10, 21, and 32.

The Applicant respectfully submits that *Jammes* has nothing to do with amended independent claim 1 limitations regarding an ***“electronic commerce system applying***

dynamic database redirection” and in particular *Jammes* has nothing to do with amended independent claim 1 limitations regarding “a ***seller selection interface*** operable to ***receive one or more seller requirements from a buyer***”. In particular, the Examiner equates receiving “***one or more seller requirements from a buyer***” recited in amended independent claim 1 with the process of identifying a consumer disclosed in *Jammes*. (15 December 2005 Office Action, Page 2). However, ***the process of identifying a consumer disclosed in Jammes*** is merely used to “identify each consumer accessing the electronic store”, and ***does not include, either expressly or implicitly, any seller requirements received from the consumer***. (Column 49, Lines 22-32). In contrast, the “***seller requirements***” recited in amended independent claim 1 are ***received from the buyer into the seller selection interface***. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Jammes* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Jammes*.

The Applicant further submits that *Jammes* has nothing to do with amended independent claim 1 limitations regarding an “a global content directory server associated with the seller selection interface, the global content directory server operable to ***generate one or more custom global content directories based on the seller requirements received from the buyer***”. In particular, the Examiner equates generating “one or more ***custom global content directories based on the seller requirements received from the buyer***” recited in amended independent claim 1 with the collection of icons representing individual products disclosed in *Jammes*. (15 December 2005 Office Action, Page 3). However, ***the collection of icons representing individual products disclosed in Jammes*** is merely an interface for the merchant in *Jammes* and ***has nothing to do with a global content directory server operable to generate custom global content directories based on the seller requirements received from the buyer***. (Column 49, Lines 22-32). In contrast, the global content directory server recited in amended independent claim 1 is generates custom global content directories “***based on the seller requirements that are received from the buyer***.” Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s

comparison between *Jammes* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Jammes*.

The Applicant still further submits that *Jammes* has nothing to do with amended independent claim 1 limitations regarding “one or more **custom global content directories** each including **a plurality of product classes** organized in a hierarchy, each product class categorizing a plurality of products from one or more sellers **satisfying the seller requirements received from the buyer** and each product class associated with one or more attributes of the products categorized in the product class, at least one of the **product classes having one or more associated pointers that identify one or more seller databases associated with sellers satisfying the seller requirements received from the buyer**”. In particular, the Examiner equates generating “categorizing a plurality of products from one or more sellers **satisfying the seller requirements received from the buyer**” recited in amended independent claim 1 with the process of monitoring the shopping behavior of consumers disclosed in *Jammes*. (15 December 2005 Office Action, Page 3). However, the process of monitoring the shopping behavior of consumers disclosed in *Jammes* is **gathered on data about the consumer, but does not include data received from the consumer**. (Column 3, Lines 20-28). In contrast, the global content directories recited in amended independent claim 1 include **product classes that categorize a plurality of products satisfying the seller requirements received from the buyer**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Jammes* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Jammes*.

The Applicant respectfully submits that the allegation in the present Office Action that *Jammes* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Jammes* is considered to anticipate all of the limitations in claims 1, 2, 4, 6-13, and 16-32. **A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.**

MPEP § 2131. (Emphasis Added). The Applicant respectfully points out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of anticipation in claims 1, 2, 4, 6-13, and 16-32 under 35 U.S.C. § 102 with respect to *Jammes* because *Jammes* fails to identically disclose each and every element of the Applicant's claimed invention, arranged as they are in Applicant's claims.

The Applicant's Claims are Patentable over *Jammes*

With respect to amended independent claims 10, 21, and 32 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 1. Thus, amended independent claims 10, 21, and 32 are considered patentably distinguishable over *Jammes* for at least the reasons discussed above in connection with amended independent claim 1.

Furthermore, with respect to dependent claims 2-9, 11-20, and 22-31: claims 2-9 depend from amended independent claim 1; dependent claims 11-20 depend from amended independent claim 10; and dependent claims 22-31 depend from amended independent claim 21 are also considered patentably distinguishable over *Jammes*. Thus, dependent claims 2-9, 11-20, and 22-31 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that amended independent claims 1, 10, 21, and 32 and dependent claims 2-9, 11-20, and 22-31 are not anticipated by *Jammes*. The Applicant further submits that amended independent claims 1, 10, 21, and 32 and dependent claims 2-9, 11-20, and 22-31 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1, 2, 4, 6-13, and 16-32 under 35 U.S.C. § 102(a) be reconsidered and that claims 1, 2, 4, 6-13, and 16-32 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.
7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.
2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The

effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 3, 14, and 15 stand rejected under 35 U.S.C. § 103(a) over *Jammes* in view of *Giovannoli*. Claim 5 stands rejected under 35 U.S.C. § 103(a) over *Jammes* in view of *Etten*.

Although the Applicant believes claims 1-32 are directed to patentable subject matter without amendment, the Applicant has amended independent claims 1, 10, 21, and 32 and dependent claims 2-7, 11-19, and 22-30 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that *Jammes* or *Giovannoli*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 3, 14, and 15. The Applicant further submits that *Jammes* or *Etten*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claim 5. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 3, 5, 14, and 15 under 35 U.S.C. § 103(a) over the proposed combination of *Jammes*, *Giovannoli*, or *Etten*, either individually or in combination.

The Proposed *Jammes-Giovannoli* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 3, 14, and 15

For example, with respect to amended dependent claims 3 and 14, these claims recite:

3. The system of Claim 2, further operable to:
determine a geographic location for the buyer and one or more languages that correspond to the geographic location of the buyer,
and

generate custom global content directories where the ***pointers identify seller databases in the languages corresponding to the geographic location of the buyer.*** (Emphasis Added).

14. **(Currently Amended)** The method of Claim 10, further comprising ***providing multi-language support based upon the geographic location of the buyer.*** (Emphasis Added).

Amended dependent claims 15, 25, and 26 recite similar limitations. *Jammes* or *Giovannoli*, either individually or in combination, fail to disclose each and every limitation of amended dependent claims 3, 14, 15, 25, and 26.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Jammes* fails to disclose the emphasized limitations noted above in amended dependent claim 3. Specifically the Examiner acknowledges that *Jammes* fails to disclose an “**electronic commerce system applying dynamic database redirection**” further operable to “**determine a geographic location for the buyer and one or more languages that correspond to the geographic location of the buyer**”. (15 December 2005 Office Action, Pages 7-8). However, the Examiner asserts that the cited portions of *Giovannoli* disclose the acknowledged shortcomings in *Jammes*. The Applicant respectfully disagrees. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Giovannoli*.

The Applicant respectfully maintains that *Giovannoli* has nothing to do with the amended dependent claim 3 limitations regarding an “**electronic commerce system applying dynamic database redirection**” and in particular *Giovannoli* has nothing to do with amended dependent claim 3 limitations regarding the electronic commerce system operable to “**determine a geographic location for the buyer and one or more languages that correspond to the geographic location of the buyer**, and generate custom global content directories where the **pointers identify seller databases in the languages corresponding to the geographic location of the buyer**.” Rather, *Giovannoli* describes an approach for processing requests for quotation through a central processing unit. (Abstract). The Applicant directs the Examiner’s attention to the cited portions of *Giovannoli*, relied upon by the Examiner:

The RFQ is then processed to select vendors who are capable of quoting on the RFQ and who meet any other conditions set by the requesting buyer (e.g. language, currency, or vendor location). (Column 5, Lines 9-12).

For example, a buyer who specifies vendors of volt meters in New York State will reach more vendors than if New York City alone were specified. Such class specifications are information filters through which only the desired vendors can pass. (Column 7, Lines 9-14).

Although, *Giovannoli* discloses a potential condition of language set by the requesting buyer and a population comparison between New York State and New York City, ***Giovannoli fails to disclose that the condition of language is associated in anyway with determining a geographic location or that the population comparison is in anyway associated with generating a custom global content directory having pointers identifying seller databases.*** Thus *Giovannoli* cannot provide for an “***electronic commerce system applying dynamic database redirection***” or even “***generat[ing] custom global content directories where the pointers identify seller databases in the languages corresponding to the geographic location of the buyer***”, since *Giovannoli* does not even provide for a condition of language associated with the user geographical location in the first place. In addition, *Giovannoli* cannot provide for “***providing multi-language support based upon the geographic location of the buyer***”, since *Giovannoli* does not even provide for multi-language support in the first place.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Jammes* and *Giovannoli*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Jammes* and *Giovannoli* as proposed. In fact, the Office Action is silent as to why it would have been obvious to one having ordinary skill in the art at the time the invention was made to use *Giovannoli* to overcome the acknowledged shortcomings in *Jammes*. (15 December 2005 Office Action, Pages 7-8).

However, the Examiner asserts that the motivation to combine *Jammes* and *Giovannoli* would be “to allow the buyers to choose sellers from locations that would be preferable from delivery and shipping cost points of views” and “to expand business into foreign countries, resulting in increase of revenue and profits for sellers.” (15 December 2005 Office Action, Pages 7-8). The Applicant respectfully disagrees and further respectfully submits that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in *Jammes* or *Giovannoli*, either

individually or in combination. ***The Applicant respectfully requests the Examiner to point to the portions of Jammes or Giovannoli which contain the teaching, suggestion, or motivation to combine Jammes or Giovannoli for the Examiners stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Jammes or Giovannoli to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that the motivation to combine *Jammes* and *Giovannoli* teachings would be "to allow the buyers to choose sellers from locations that would be preferable from delivery and shipping cost points of views" and "to expand business into foreign countries, resulting in increase of revenue and profits for sellers", ***does not adequately address the issue of motivation to combine.*** (15 December 2005 Office Action, Pages 7-8). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Jammes or Giovannoli***, either individually or in combination.

The Proposed *Jammes-Etten* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claim 5

For example, with respect to amended dependent claim 5, this claim recites:

The system of Claim 1, wherein ***the search query comprises desired values, specified by the buyer***, for one or more of the product attributes associated with the selected product class. (Emphasis Added).

Amended dependent claims 16 and 27 recite similar limitations. *Jammes* or *Etten*, either individually or in combination, fail to disclose each and every limitation of amended dependent claims 5, 16, and 27.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Jammes* fails to disclose the emphasized limitations noted above in amended dependent claim 5. Specifically the Examiner acknowledges that *Jammes* fails to disclose an “***electronic commerce system applying dynamic database redirection***” wherein “***the search query comprises desired values, specified by the buyer***, for one or more of the product attributes associated with the selected product class.” (15 December 2005 Office Action, Pages 8-9). However, the Examiner asserts that the cited portion of *Etten* disclose the acknowledged shortcomings in *Jammes*. The Applicant respectfully disagrees. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Etten*.

The Applicant respectfully submits that *Etten* has nothing to do with the amended dependent claim 5 limitations regarding an “***electronic commerce system applying dynamic database redirection***” and in particular *Etten* has nothing to do with amended dependent claim 5 limitations regarding the electronic commerce system “wherein ***the search query comprises desired values, specified by the buyer***, for one or more of the product attributes associated with the selected product class.” Rather, *Etten* describes a procurement system for special item purchases that are not found when searching a catalog database. (Abstract). The Applicant directs the Examiner’s attention to the cited portions of *Etten*, relied upon by the Examiner:

[0031] Once a leaf class is selected, a parametric search engine is presented as shown at point 94. The parametric search engine presents the attributes associated with a specific item leaf class and valid values associated with each attribute. The attributes can be presented in a variety of selection objects, such as drop-down boxes, list boxes, and sets of check boxes as shown in the example of FIG. 6. The user selects the value and

clicks an operator button. Within the Parametric Search, there is an undo button that removes the value in the search for items.

Etten fails to disclose that this parametric search engine provides the ability to communicate a search query to a seller database specified by a buyer for one or more of the product attributes associated with the selected product class. In fact, the parametric search engine cited by the Examiner in *Etten*, is actually associated with selection objects, such as predetermined drop-down boxes and is not in anyway associated with, or related to, the search interface operable to communicate a search query to the seller databases in the subject Application. Thus *Etten* cannot provide for an “**electronic commerce system applying dynamic database redirection**” or even the electronic commerce system “wherein **the search query comprises desired values, specified by the buyer**, for one or more of the product attributes associated with the selected product class”, since *Etten* does not even provide for a search interface operable to communicate a search query to the seller databases in the first place.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Jammes* and *Etten*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Jammes* and *Etten* as proposed. In fact, the Office Action is silent as to why it would have been obvious to one having ordinary skill in the art at the time the invention was made to use *Etten* to overcome the acknowledged shortcomings in *Jammes*. (15 December 2005 Office Action, Pages 8-9).

However, the Examiner asserts that the motivation to combine *Jammes* and *Etten* is that “the use of the class/attribute/value approach permits a comparison of multiple items that meet the parametric search criteria and the selection of the item that meets the buyer’s specific requirements.” (15 December 2005 Office Action, Page 9). The Applicant respectfully disagrees and further respectfully submits that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught,

or suggested in *Jammes* or *Etten*, either individually or in combination. ***The Applicant respectfully requests the Examiner to point to the portions of Jammes or Etten which contain the teaching, suggestion, or motivation to combine Jammes or Etten for the Examiners stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Jammes or Etten to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that the motivation to combine *Jammes* and *Etten* teachings is that "the use of the class/attribute/value approach permits a comparison of multiple items that meet the parametric search criteria and the selection of the item that meets the buyer's specific requirements", ***does not adequately address the issue of motivation to combine.*** (15 December 2005 Office Action, Pages 7-8). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Jammes or Etten***, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed *Jammes-Giovannoli-Etten* Combination

As mentioned above, amended independent claims 1, 10, 21, and 32 are considered patentably distinguishable over *Jammes*, *Giovannoli*, and *Etten*. With respect

to dependent claims 3, 5, 14-16, and 25-27: claims 3 and 5 depend from amended independent claim 1; claims 14-16 depend from amended independent claim 10; and claims 25-27 depend from amended independent claim 21. As mentioned above, each of independent claims 1, 10, 21, and 32 are considered patentably distinguishable over the proposed combination of *Jammes*, *Giovannoli*, and *Etten*. Thus, dependent claims 3, 5, 14-16, and 25-27 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant submits that claims 3, 5, 14-16, and 25-27 are not rendered obvious by the proposed combination of *Jammes*, *Giovannoli*, and *Etten*. The Applicant further submits that claims 3, 5, 14-16, and 25-27 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 3, 5, 14-16, and 25-27 under 35 U.S.C. § 103(a) be reconsidered and that claims 3, 5, 14-16, and 25-27 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there ***must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, ***of making the***

combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

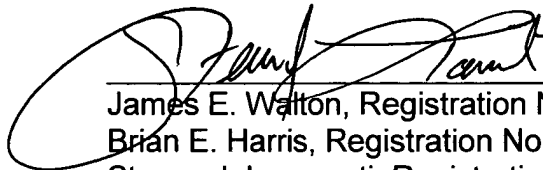
In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

2/16/06
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